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REMARKS

This communication is responsive to the Final Office Action dated October 18, 2005.

Claims 70-79 and 81-91 are pending.

Applicants acknowledge and thank the Examiner for withdrawing the objections to claims 70, 73, 81 and 83.

Claims 70-79 and 81-91 have been rejected.

We hereby respectfully traverse all of the rejections, as the pending claims are patentably distinct from the cited art. In view of the comments that follow, the Applicants respectfully request that the Examiner reconsider and withdraw all of the Section 103(a) rejections.

Section 103(a) Rejections

All of the pending claims (Claims 70-79 and 81-91) stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over U.S. Patent No. 5,909,673 issued to Gregory ("Gregory") in view of U.S. Patent No. 5,377,271 issued to Foreman et al. ("Foreman").

We respectfully reassert and incorporate by reference the arguments made in the Amendment and Response filed July 28, 2005 that independent Claims 70, 73, 76, 77, 78, 79, 81, 83 and 91 are not obvious in light of Gregory or Foreman, either alone or in combination. We also make some further arguments below for the Examiners' review and consideration.

Gregory fails to teach or suggest the method for issuing a gift certificate corresponding to a financial account as recited by pending independent claims 70, 73, 76, 77, 78, 79, 81, 83 and 91. In particular, as recognized on page two, paragraph 4 of the final Office Action, Gregory fails to teach to produce a gift certificate that includes a certificate identifier that corresponds to an account identifier associated with a financial account, and that does not include the account identifier, as recited by independent claims 70, 73, 76, 78 and 79. Further, Gregory fails to teach to produce a gift certificate with a certificate identifier that is an alias of an account identifier or financial account or credit card account, as recited by independent claims 81, 83 and 91.

We also note that Gregory fails to suggest or teach to distribute the gift certificate to the owner of the financial account as recited in independent claims 70, 76, 78 and 81. In fact, Gregory teaches away from such a method by teaching processes and systems that, for example, print payroll checks on demand for a

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manager at a store location for distribution to the store employees, which most likely includes the manager himself (col. 6, lines 51-55). It does not appear that the store manager and the employees are the "owner of the financial account".

The Applicants respectfully assert that Foreman does not cure the deficiencies of Gregory, for the reasons set forth below.

Foreman pertains to a two-part money order dispenser 10 having a control terminal 12 and a separate, secure printer 20 (See, for example, Fig. 1 and col. 1, lines 13-16, col. 4, lines 53-60, and col. 5, lines 16-25). The printer 20 is contained within a housing 22, and specially prepared, fan-folded money order forms 24 (shown in Fig. 6) are stored therein (col. 6, lines 3-6). As depicted in Figs. 8 and 9 of Foreman, the money order forms 24 have a serial number 34 pre-printed along a leading edge (Fig. 8), and the money order forms also include associated timing marks 38 (Fig. 9) on the back of each one that help to prevent fraud. Foreman describes how each timing mark 34 falls in a predetermined numbered sequence in the fan folded bundle 50 of money order forms 24. In order for printing to take place, the corresponding serial number 34 of a particular money order that bears the timing mark must be evenly devisable by the number of the position location of the form in the bundle. For example, if the timing mark 38 appears on every fourth money order form, then the serial number must be divisible by four or else printing of the money order will not occur and the sequence must be checked by the operator of the dispenser (col. 6, lines 25-47).

We respectfully submit that Foreman fails to teach to produce a gift certificate that includes a certificate identifier corresponding to an account identifier associated with a financial account, and wherein the gift certificate does not include the account identifier as required by independent claims 70, 73, 76, 77, 78, and 79. Foreman also fails to teach to produce a gift certificate with a certificate identifier that is an alias of an account identifier, or financial account, or credit card account, as recited by independent claims 81, 83 and 91.

It is noted that the "Travelers Express" money order depicted in Figs. 8 and 9 of Foreman contains a series of numbers in the lower right corner. In particular, a 13-digit number is shown on top of a 4-digit number that is next to an 11-digit number. As best understood by Applicants, it is believed that the Examiner has taken these numbers as representative of "multi-level security codes" mentioned in Foreman, and cites to col. 7, lines 3-19 to support such a conclusion (See Final Office Action, page 3, lines 1-6). But the verbiage at col. 7, lines 3-19 has nothing whatsoever to do with "security codes", rather this section of Foreman concerns storing vendor names in the memory 18 associated with the terminal 12, and then

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downloading the vendor name to the memory 40 associated with the printer 20 for printing on the payee line 80 of the money order form 24.

Furthermore, Forman discloses using multi-level security codes that are stored in a memory associated with the terminal for the purposes of internal control and operator security (See col. 8, lines 5-85). Foreman does not even suggest that such security codes are ever printed on the money order, and we submit that to do so would compromise the security of Foreman's system. Moreover, it is conjecture to interpret these digits shown in Figs. 8 and 9 on the "Travelers Express" check as being (i) some type of a security code instead of an account identifier, or (ii) a certificate identifier corresponding to (but different than) an account identifier, as there is no mention whatsoever in Foreman regarding what these digits mean or represent (Final Office Action, page 7, lines 4-12).

Consequently, Foreman does not teach or suggest producing a gift certificate that includes a certificate identifier corresponding to an account identifier that is associated with a financial account and that is different from the account identifier, and wherein the gift certificate does not include the account identifier as recited in independent claims 70, 73, 76, 77, 78 and 79. In addition, Foreman also fails to teach to produce a gift certificate with a certificate identifier that is an alias of an account identifier or financial account or credit card account, as recited by independent claims 81, 83 and 91. Thus, Foreman fails to cure these deficiencies of Gregory. It is also noted that Foreman fails to suggest or teach to distribute the gift certificate to the owner of the financial account, as recited in independent claims 70, 76, 78 and 81.

Furthermore, we respectfully reassert that there is no teaching or suggestion in either Gregory or Forman (or otherwise supported by evidence of record) to combine them. This rejection is therefore a hindsight reconstruction, using Applicants' claims as a template to reconstruct the invention by picking and choosing isolated disclosures from the prior art. This is impermissible. For example, in *In re Fritch,* 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), the Federal Circuit Stated:

> It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teaching of the prior art so that the claimed invention is rendered obvious. *In re Gorman,* 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (Quoting *In re Fine,* 837 F.2d at 1075, 5 USPQ2d at 1600).

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The present rejection fits the court's description of what may not be done under Section 103. The Examiner merely listed certain components of Applicants' invention and then located isolated disclosures of those components. The law requires more than that.

The Examiner must show where the prior art provides a motivation to combine the references she has combined in the obviousness rejection. Absent a motivation to combine, obviousness has not been demonstrated. As the Federal Circuit stated in *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990):

> It is insufficient that the prior art disclosed the components of the patented device, either separately or used in combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.

The Examiner has failed to point out any teaching, suggestion or incentive in either of Gregory or Foreman for their combination.

Furthermore, the Applicants respectfully assert that one skilled in the art would not combine Gregory and Foreman in the manner suggested because Gregory teaches away from such a combination. In particular, a primary object of Gregory is to provide a method and system for automatically creating a financial instrument by using blank paper in order to avoid sequencing and transaction log problems of the prior art (See Gregory, col. 3, lines 27-30 and col. 4, lines 17-38). In stark contrast, as explained above, Foreman's system can only work with fan-folded money order forms that contain both pre-printed serial numbers and pre-printed timing marks. The serial numbers and timing marks are an essential component of Foreman's invention that are used to prevent fraud (See Foreman, col. 6, lines 25-47), and thus these features cannot be discarded. It is noted that Foreman is exactly the type of prior art system that is made obsolete by Gregory's invention, and that is why Foreman was cited during prosecution of the Gregory patent application.

Yet further, even if Gregory and Foreman were combined as suggested by the Examiner, and again there is no teaching or suggestion in either reference for such combination, the present invention would not be the result. Accordingly, independent claims 70, 73, 76, 77, 78, 79, 81, 83 and 91 are patentably distinct over Gregory and Foreman, taken alone or in combination.

Since claims 71, 72, 74, 75, 82 and 84-90 each depend on one of independent claims 70, 73, 76, 77, 78, 79, 81, and 83, these dependent claims should be allowable for at least the same reasons.

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Application No.: 09/613,361
Attorney Docket No.: 96-140-C1

Accordingly, the Applicants respectfully request withdrawal of all of the Section 103(a) rejections and allowance of the present application.

Conclusion

In view of the above remarks, the Applicants respectfully submit that all of the claims are in condition for allowance, early notice of which would be appreciated. If the Examiner has any questions or does not agree that all pending claims are allowable, the Examiner is cordially requested to contact Stephan Filipek at telephone number (203) 461-7252 or via electronic mail at sfilipek@walkerdigital.com.

It is believed that no fees are due for the submission of this Response as it is being filed within three months of the mailing date of the Final Office Action. However, should any fees accrue, please grant a petition for any extension of time required to make this Response timely.

If necessary, please charge any appropriate fees necessary per the following information:
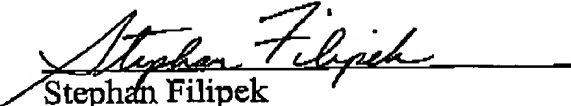
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Respectfully submitted,

January 5, 2006
Date

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